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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,370

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Robert M. Schumacher

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AT & T Legal Department - BHGL
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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/773,370	Applicant(s) SCHUMACHER ET AL.	
	Examiner JOSHUA D. CAMPBELL	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 5/20/2009.
2. Claims 65-98 are pending in this case. Claims 65 and 73 are independent claims. Claims 67, 68, 75, and 76 have been amended. Claims 97 and 98 have been newly added.
3. The rejection of Claims 67, 68, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst ("Using Netscape" published in 1995) in view of Swonk (US Patent Number 5,867,729, issued February 2, 1999) has been withdrawn, a new grounds of rejection has been applied.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 67, 68, 75, 76, 97, and 98 rejected under 35 U.S.C. 102(e) as being anticipated by Dickman et al. (hereinafter Dickman, US Patent Number 6,091,409, US filing date of September 11, 1995).

Regarding dependent claims 67 and 68, Dickman explicitly discloses programmatic steps for automatically configuring portions of web information (URLs) to correspond with buttons (hot keys – by definition shortcut keys to activate the element they refer to) based on a default configuration (predefined format) to the exclusion of other web information (column 9, line 38-column 10, line 5 and column 10, line 50-column 11, line 10 of Dickman). Dickman discloses that the URL shortcuts (at least a first and a second) have associated hot keys, which by definition when activated (button pressed) will cause display of the corresponding portion of web information (column 9, line 38-column 10, line 5 and column 10, line 50-column 11, line 10 of Dickman).

Additionally, Dickman contains a second teaching that properly renders the claimed limitations obvious. Dickman also discloses the notoriously well-known technology of providing recently viewed web documents as shortcuts accessible with keyboard shortcuts, as displayed in the “File” menu as the selection options denoted as “1” and “2” (first selection and second selection) (Figure 7, item 62 of Dickman). These keyboard shortcuts are automatically configured and provided to the user in a preloaded default form based on recently viewed documents with absolutely no interaction by the user. When the keyboard shortcut is activated (button pressed) the document referenced by the shortcut is displayed to the user to the exclusion of other web information.

Regarding dependent claims 75 and 76, the claims incorporate substantially similar subject matter as claims 67 and 68. Thus, the claims are rejected along the same rationale as claims 67 and 68.

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Regarding dependent claims 97 and 98, in both of the teachings of Dickman the shortcuts in whatever form they exist (icons or recently viewed selectable options) are by definition “predefined”, because they must be *defined before (in other words predefined)* the user can operate said shortcut in their respective forms (column 9, line 38-column 10, line 5 and column 10, line 50-column 11, line 10 of Dickman and Figure 7, item 62 of Dickman).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 65, 66, 69-74, and 77-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst ("Using Netscape" published in 1995) in view of Swonk (US Patent Number 5,867,729, issued February 2, 1999).

Regarding independent claim 65, Ernst discloses displaying a first portion of web information when a first selection is made (bookmark) and displaying a second portion of web information when a second selection is made (pages 63-64, "Jump to pages you've marked with bookmarks" of Ernst). Ernst does not disclose that the selection is made by pressing a first button and a second button respectively. However, Swonk discloses the ability to bind functions (such as the navigation function provided by the bookmarks of Ernst) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the Ernst, different bookmarks) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding dependent claim 66, Ernst does not explicitly disclose that performing of said functions are a result of the user pressing keys corresponding to the search functions or that the keys are arranged in a row. However, Swonk discloses the ability to bind functions (such as the navigation function provided by the bookmarks of

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Ernst) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the Ernst, different bookmarks) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding dependent claims 69 and 70, Ernst discloses that when the first and second portions of information are displayed they are displayed irrespective of a relationship with whatever web information is displayed in the window when the selection is received (pages 63-64, "Jump to pages you've marked with bookmarks" of Ernst).

Regarding dependent claims 71 and 72, Ernst teaches using Netscape which is installed and used on a computer with a mass storage device (to store the program and bookmarks) and display (for the user to view the documents) (pages 61-62, "Keeping a Map with Bookmarks" of Ernst).

Regarding dependent claims 81 and 83, Ernst discloses the use of bookmark navigation which operates independently of scroll functionality for portions of web information that are not part of a larger scrollable portion of information (pages 63-64, "Jump to pages you've marked with bookmarks" of Ernst). Ernst does not explicitly

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disclose that performing of said functions as a result of the user pressing keys corresponding to the search functions. However, Swonk discloses the ability to bind functions (such as the navigation function provided by the bookmarks of Ernst) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the Ernst, different bookmarks) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding dependent claims 85-87, Ernst discloses displaying a first portion of web information when a first selection is made (bookmark) and displaying a second portion of web information when a second selection is made the web information being defined by data (URL) (pages 63-64, "Jump to pages you've marked with bookmarks" of Ernst). Ernst discloses that when the selection is made of a bookmark a search for the URL, which comprises both characters and symbols, is initiated to locate and access the web information (pages 63-64, "Jump to pages you've marked with bookmarks" and example of URL on page 62 of Ernst). Ernst does not disclose that the selection is made by pressing a first button and a second button respectively. However, Swonk discloses the ability to bind functions (such as the navigation function provided by the bookmarks of Ernst) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus

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allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk).

Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the Ernst, different bookmarks) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding dependent claims 91, 92, and 95, Ernst does not explicitly disclose that performing of said functions as a result of the user pressing keys corresponding to the search functions or that the keys are arranged in a row. However, Swonk discloses the ability to bind functions (such as the navigation function provided by the bookmarks of Ernst) to the Function Key combinations (i.e. F1-F12) on a keyboard, thus allowing specific functions to be performed when the user presses the keys that the functions have been assigned to (Figure 4 and column 10, lines 22-54 of Swonk). Swonk discloses that the Function Key combinations may all have different functions bound to them (in the case of the Ernst, different bookmarks) (Figure 4 and column 10, lines 22-54 of Swonk). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst with the teachings of Swonk because it would have allowed for increased usability for users with no pointing device available.

Regarding independent claim 73 and dependent claims 74, 77-80, 82, 84, 88-90, 93, 94, and 96, the claims incorporate substantially similar subject matter as claims 65, 66, 69-72, 81, 83, 85-87, 91, 92, and 95. Thus, the claims are rejected along the same rationale as claims 65, 66, 69-72, 81, 83, 85-87, 91, 92, and 95.

Regarding dependent claims 97 and 98, in the teachings of Ernst and Swonk the shortcuts in whatever form they exist (Ernst – bookmarks, Swonk – Function key bindings) are by definition “predefined”, because they must be *defined before (in other words predefined)* the user can operate said shortcut in their respective forms (pages 63-64, “Jump to pages you’ve marked with bookmarks” of Ernst and Figure 4 and column 10, lines 22-54 of Swonk)

9. Claims 67, 68, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst (“Using Netscape” published in 1995) in view of Swonk (US Patent Number 5,867,729, issued February 2, 1999) as applied to claims 65 and 73 above, and further in view of Dickman et al. (hereinafter Dickman, US Patent Number 6,091,409, US filing date of September 11, 1995).

Regarding dependent claims 67 and 68, neither Ernst nor Swonk explicitly disclose that the buttons are automatically configured to correspond to the portions according to a default configuration to the exclusion of other web information. However, Dickman explicitly discloses programmatic steps for automatically configuring portions of web information (URLs) to correspond with buttons (hot keys – by definition shortcut keys to activate the element they refer to) based on a default configuration (predefined

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format) to the exclusion of other web information (column 9, line 38-column 10, line 5 and column 10, line 50-column 11, line 10 of Dickman). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Ernst and Swonk with the teachings of Dickman because it would have provided the user with a simpler way to access Internet information.

Additionally, Dickman contains a second teaching that properly renders the claimed limitations obvious. Dickman also discloses the notoriously well-known technology of providing recently viewed web documents as shortcuts accessible with keyboard shortcuts, as displayed in the "File" menu as the selection options denoted as "1" and "2" (Figure 7, item 62 of Dickman). These keyboard shortcuts are automatically configured and provided to the user in a preloaded default form based on recently viewed documents with absolutely no interaction by the user. When the keyboard shortcut is activated the document referenced by the shortcut is displayed to the user to the exclusion of other web information. It would have been obvious to one of ordinary skill in the art to have combined the teachings of Ernst and Swonk with the notoriously well-known functionality displayed in the teachings of Dickman because it would have allowed the user to quickly access documents that have been previously viewed by the user.

Regarding dependent claims 75 and 76, the claims incorporate substantially similar subject matter as claims 67 and 68. Thus, the claims are rejected along the same rationale as claims 67 and 68.

Response to Arguments

10. Applicant's arguments with respect to claims 67, 68, 75, 76, 97, and 98 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed 5/20/2009 have been fully considered but they are not persuasive.

Regarding applicant's arguments on pages 11-13 (section "B."), in reference to whether it would have been obvious to one of ordinary skill in the art to combine the teachings of Ernst and Swonk, the examiner respectfully disagrees and maintains that the rejection is proper. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Swonk discloses applying keyboard shortcuts in order to perform actions, which is also a notoriously well known technology in the art. The fact that the Ernst reference does not already have the explicit functionality as claimed has no effect on whether or not it would have been obvious to one of ordinary skill to modify the teachings of Ernst based on the teachings of Swonk. In this case, the mere fact that the teachings of Swonk provide a motivated benefit of using keyboard shortcuts to perform actions, which again is not only taught by Swonk but is notoriously well-known is more than enough to

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provide a basis that it would have been obvious to one of ordinary skill in the art to combine the teachings of the two reference. Thus, the rejection remains proper.

Regarding applicant's arguments on page 13 (section "C."), in reference to whether the proffered motivation to combine is sufficient, the examiner respectfully disagrees and maintains that the rejection is proper. The applicant appears to be arguing that an Internet browser can not be operated without a pointing device. The examiner recommends the applicant take a look at Netscape Navigator version 2.0 and/or Internet Explorer version 2, however since this is not a requirement in the claimed limitations nor is it a requirement to validate the rejection the examiner will not be providing any reference of any sort that proves a browser can be operated without a pointing device. The examiner will take the time to note, that the Ernst reference, the applicant's analysis of the Ernst reference (see pages 11-13 of Applicant's arguments), and the newly cited Dickman reference all show the ability to operate a web browser with the keyboard. In this case the burden of proof lies with the applicant, in order to dispute the claim based on the references that have been provided that show a browser could be run with only keyboard commands, the applicant would have to prove that in fact browsers at the time could not be run using only a keyboard, again the examiner believes that whether or not this is proved has absolutely no effect on the claimed limitations or the rejections presented. Thus, the rejection remains proper.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
August 7, 2009